

DETAILED ACTION

Response to Amendment

Applicant's amendment filed on October 22, 2008 is acknowledged.

Rejection is maintained as it was set forth in previous Office action mailed on July 22, 2008.

1. The Declaration under 37 CFR 1.132 filed October 22, 2008 is sufficient to overcome the rejection of Claims 1,5,7,10 and 28 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement as it was set forth in previous Office action mailed on July 22, 2008. Furthermore, the showing in this Declaration is deemed to be commensurate in scope with the scope of the claims with respect to the spherical nature of the particles and the core portion.
2. Per Applicant's request IDS filed on October 22, 2008 was considered by Examiner and attached to this Office action.

Status of Claims

3. It is noted that status of Claims 26-27 and 29-31 has not been changed. According applicant's respond filed on June 20, 2008 Claims 26-27 and 29-31 were withdrawn as Non-elected. **Appropriate correction of the status of Claims 26-27 and 29-31 is required.**

Claim 33 is newly added. Claims 1, 5,7,10, 28 and 33 are active. Claims 2-4,6,8-9,25 and 32 are cancelled. Claims 11-24, 26-27 and 29-31 are withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, support for new limitation of Claim 1 as " when an additive is present in the particle, the additive is distributed in the shell or in both the core and shell of the particle " was not found in paragraph [0115] and [0116] of Specification as it was pointed out by Applicant. Same related to limitation of new Claim 33 - see last clause - as " consisting of ".

Therefore, limitation of Claim 1 as " when an additive is present in the particle, the additive is distributed in the shell or in both the core and shell of the particle " and limitation of Claim 33 (see last clause) as " consisting of " represent New Matter until Applicant can point for support for those limitations in original specification.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 5,7,10, 28 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Moffat et al(US 4,937,167).

Regarding Claims 1, 28 and 33 Moffat discloses toner particles, comprising styrenic polymer as a core (see column 11, lines 37-55) and polyamide as material for shell (see column 15,lines 49-54), wherein particles and core are spherical (see column 29, line 39) and Fig.1.

Regarding new limitation of Claim 1 and last clause of Claim 33 Moffat discloses that toner particle may comprise additive as, for example, charge control agent , distributed in shell (see column 7, lines 7 -12) and toner particle with out colorant (see column 20, line 39 - 42). Thus new limitation of Claim 1 and limitation in last clause of Claim 33 are satisfied.

Regarding limitation of Claim 1 related to hydrophobic/ hydrophilic properties of polymer A1 and A2 : because core and shell polymer materials are substantially same as it claimed by applicant they will poses same properties, including hydrophobic/ hydrophilic properties.

Regarding Claim 10 Moffat discloses, that preferably particles posses mean diameter of less than 10 microns and narrow size distribution (see column 1, lines 25 - 34).

Regarding Claim 7 Moffat discloses that shell can be present in the amount from 5 to 50 wt.% of the toner particle(see claim 19) and core can be present in the amount from 35 to 90 wt% of the particles - therefore, limitation of Claim 7 is satisfied.

Note, that Moffat is silent regarding limitation of Claim 5 as shell thickness. However, because particle structure as size and weight ratio between core and shell is substantially same as it claimed by Applicant, shell thickness will be inherently also substantially same.

Thus, Moffat clearly anticipated subject matter claimed by Applicant in Claims 1,5,7,10, 28 and 33.

Response to Arguments

6. Applicant's arguments filed on October 22, 2008 with respect to claims 1, 5, 7, 10, 28 and 33 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments related to Claims 1, 5,7,10 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Moffat et al (US 4,937,167) based on statement that toner particle disclosed by Moffat " must have a colorant".

This argument was found unpersuasive, because Moffat disclosed toner particle made with out colorant - see column 20, line 39 - 42.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GENNADIY MESH whose telephone number is (571)272-2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272 1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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